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09/866,425	05/24/2001	Andrew J. Vilcauskas JR.	Exit:Post1	5992

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EXAMINER

WASSUM, LUKE S

ART UNIT	PAPER NUMBER
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2167

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/866,425

Applicant(s)

VILCAUSKAS ET AL.

Examiner

Luke S. Wassum

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>03062007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Applicants' amendment, filed 6 March 2007, has been received, entered into the record, and considered.
2. As a result of the amendment, claims 21 and 31 have been amended. Claims 21-42 remain pending in the application.

Priority

3. The Applicants' claim to domestic priority under 35 U.S.C. §119(e), to provisional application 60/207,698, filed 26 May 2000, is acknowledged. Since the subject matter of the parent provisional application encompasses that of the instant application and claims, a priority date of 26 May 2000 is hereby established.

The Invention

4. The claimed invention is drawn to a method of presenting advertisements in a computer system through the use of popunder windows. Alternative claimed embodiments are implemented in other media, such as a PDA, telephone, television and radio.

Information Disclosure Statement

5. The Applicants' Information Disclosure Statement, filed 6 March 2007, has been received and entered into the record. Since the Information Disclosure Statement complies with the provisions of MPEP § 609, the references cited therein have been considered by the examiner. See attached form PTO-1449.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 41 and 42 are rejected under 35 U.S.C. 102(a) as being anticipated by **Werkhoven** (WIPO Publication WO/1999/59097).

8. Regarding claim 41, **Werkhoven** teaches a system for Internet advertising for use in a media capable of simultaneously maintaining a foreground window and at least

one background window and capable of displaying a first browser in a said foreground window for selectively browsing the Internet, said system comprising a script handler that invokes a post-session procedure in said first browser (see disclosure that the system is implemented through the use of JavaScript, page 2, lines 9-10; see also page 3, lines 3-4; see also page 5, lines 1-15), said post-session procedure opening an advertisement in a second browser and maintaining said second browser in a said background window while said first browser is simultaneously displayed in said foreground window (see page 3, lines 7-10; see also drawing Figure 1).

9. Regarding claim 42, **Werkhoven** additionally teaches a system for Internet advertising where the script handler comprises code in a web page displayed in said first browser (see disclosure that the system is implemented through the use of JavaScript, page 2, lines 9-10; see also page 3, lines 3-4; see also page 5, lines 1-15).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 21-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Landsman et al.** (U.S. Patent Application Publication 2003/0004804) in view of **Werkhoven** (WIPO Publication WO/1999/59097).

14. Regarding claim 21, **Landsman et al.** teaches a system for Internet advertising for use in a media capable of simultaneously maintaining a foreground window and at least one background window and capable of displaying a first browser in a said foreground window for selectively browsing the Internet substantially as claimed, said system comprising:

- a) a script handler that invokes a post-session procedure in said first browser (see disclosure that HTML advertising tags are embedded in a web page, Abstract; see also Figures 2A and 2B); and
- b) an event handler that receives, from an Internet address, a link to an advertisement and loads said advertisement (see paragraphs [0003], [0016], [0017], [0036]-[0038], [0087], [0095], [0107] and [0109]).

Landsman et al. does not explicitly teach a system wherein said post-session procedure opens a second browser in a background window while said first browser is

simultaneously displayed in said foreground window, and wherein said advertisement is loaded into said second browser in said background window.

Werkhoven, however, teaches a system wherein said post-session procedure opens a second browser in a background window such that said opening is free from said background window obscuring any portion of said foreground window while said first browser is simultaneously displayed in said foreground window, and wherein said advertisement is loaded into said second browser in said background window (see page 3, lines 7-10; see also drawing Figure 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to open a browser in the background and load the advertisement directly into the browser, since this would help to ensure that the advertisement was actually viewed by a user, precluding the possibility that the user might cancel the advertisement window before the advertisement was fully loaded and displayed (see page 1, lines 21-26).

15. Regarding claim 31, **Landsman et al.** teaches a post-session advertising method for use in media capable of simultaneously maintaining a background window and a foreground window, said method comprising the steps of:

- a) embedding post-session instructions into a first browser, said first browser for being displayed in said foreground window (see disclosure that HTML advertising tags are embedded in a web page, Abstract; see also Figures 2A and 2B);
- b) said post-session instructions receiving, from an Internet address, a link to an advertisement (see discussion of a request for, and receipt of, an AdDescriptor file, a text file containing a list of file names and corresponding URLs at which these files reside, paragraphs [0103] through [0107]); and
- c) loading said advertisement (see paragraph [0107]).

Landsman et al. does not explicitly teach a method wherein said post-session instructions open a second browser in a background window while said first browser is simultaneously displayed in said foreground window, and wherein said advertisement is loaded into said second browser in said background window.

Werkhoven, however, teaches a method wherein said post-session procedure opens a second browser in a background window such that said opening is free from said background window obscuring any portion of said foreground window while said first browser is simultaneously displayed in said foreground window, and wherein said advertisement is loaded into said second browser in said background window (see page 3, lines 7-10; see also drawing Figure 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to open a browser in the background and load the advertisement directly into the browser, since this would help to ensure that the advertisement was actually viewed by a user, precluding the possibility that the user might cancel the advertisement window before the advertisement was fully loaded and displayed (see page 1, lines 21-26).

16. Regarding claims 22 and 32, **Werkhoven** additionally teaches a system and method wherein said second browser is opened in response to a load-triggering event (see step 3 in drawing Figure 1, showing that the load-triggering event was the loading of the web page).

17. Regarding claims 23 and 33, **Werkhoven** additionally teaches a system and method wherein said load-triggering event comprises at least one of clicking on an off-site link, entering a new address, refreshing a web site, exiting a web site, and being redirected to a web site (see step 3 in drawing Figure 1, showing that the load-triggering event was the loading of the web page, analogous to both refreshing a web site and being redirected to a web site, since both would entail the loading of the web page).

18. Regarding claims 24, 25, 34 and 35, **Landsman et al.** additionally teaches a system and method wherein said script handler delays invocation of said post-session procedure for a predetermined period of time, and wherein said script handler cancels invocation of said post-session procedure if a user loads a new web site in said first browser before said predetermined time period has elapsed (see disclosure of the timer based frame targeted advertisements, paragraph [0159]).

19. Regarding claims 26 and 36, **Landsman et al.** additionally teaches a system and method wherein said second browser is displayed in a foreground window after the occurrence of a view-triggering event (see paragraphs [0037] and [0038]).

20. Regarding claims 27 and 37, **Landsman et al.** additionally teaches a system and method including a focus timer that tracks the duration that said second browser is displayed in said foreground window (see paragraph [0050]).

21. Regarding claims 28 and 38, **Landsman et al.** additionally teaches a system and method wherein said media comprises one of a computer, a PDA, a cell phone and a television (see disclosure that the system is executed in a computer, Abstract).

22. Regarding claims 29 and 39, **Landsman et al.** additionally teaches a system and method wherein said event handler selects and returns one of a plurality of advertisements maintained at said Internet address (see paragraph [0104]).

23. Regarding claims 30 and 40, **Werkhoven** additionally teaches a system and method capable of opening a plurality of second browsers, each maintained in a separate background window, said event handler capable of receiving a link to an advertisement for each browser and loading a respective said advertisement into each said second browser while each said second browser remains in its respective said background window (see disclosure of prior art systems where a new window is

opened every time a user attempts to view the top level (home page) of a site, thus resulting in multiple windows being generated, page 3, lines 33-37).

Response to Arguments

24. Applicant's arguments filed 7 March 2007 have been fully considered and are persuasive, particularly with respect to the document submitted with the Information Disclosure Statement of 7 March 2007.

In view of the fact that the URL www.happytime.com belonged to a pornographic web site, the exhibit submitted with the Applicants' Declaration under 37 C.F.R. § 1.131 taught effectively the same subject matter as the porn rodeo reference, and thus is sufficient to remove it as prior art.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shuster (U.S. Patent 6,904,453) teaches a method and system for directing access to content on a computer network.

Shuster (U.S. Patent Application Publication 2001/0001863) teaches a method and system for directing access to content on a computer network.

Shuster (U.S. Patent Application Publication 2002/0169829) teaches a method and system for directing access to content on a computer network.

Werkhoven (U.S. Patent Application Publication 2003/0048293) teaches a method of providing Internet advertisements through the generation of a background window which is loaded with an advertisement and then displayed in the foreground.

Werkhoven (U.S. Patent Application Publication 2005/0096983) teaches a method of providing Internet advertisements through the generation of a background window which is loaded with an advertisement and then displayed in the foreground.

Shuster (U.S. Patent Application Publication 2005/0203996) teaches a method and system for directing access to content on a computer network.

Werkhoven (International Publication WO 2004/107224) teaches a method of providing Internet advertisements through the generation of a background window which is loaded with an advertisement and then displayed in the foreground.

Festa ("GeoCitizens Bristle at Pop-Up Ads") discusses the impact of the introduction of pop-up ads on the GeoCities web hosting service.

Kornblum ("N.Y. Times Tries Pop-Up Ads") discusses the impact of the introduction of pop-up ads on the New York Times web site.

Creative Edge Internet Services ("Welcome to Creative Edge Internet Services") discloses the feature of the Netbreak system.

McCloskey ("Rich Media Down Under") discusses the events of Adforum 2000, including news about Creative Edge Internet Services and their Netbreak service.

Weintraub ("Trends Report - Internet Arbitrage: A Short History") discloses evidence that the widespread adoption of pop-under advertising did not occur until the second quarter of 2001.

SpecificMedia ("About Us > Our Team > Tim Vanderhook") discloses evidence that the pop-under advertising unit of Specific Media, Inc. was not created until some time in 2001.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119. Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Luke S. Wassum
Primary Examiner
Art Unit 2167

lsw

27 April 2007